

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed May 7, 2008. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **Claim Rejections - 35 U.S.C. § 103(a)**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden 35 U.S.C. § 103 to establish obviousness by showing objective teachings in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The key to supporting an allegation of obviousness under 35 U.S.C. § 103 is the clear articulation of the reasons why the Examiner believes that claimed invention would have been obvious. See MPEP § 2141. As stated by the Supreme Court, "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR v. Teleflex*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Applicant respectfully submits that the Examiner has not established with clearly articulated reasons why Applicant's claims are obvious in view of the prior art. Applicant discusses those claims in the following.

**A. Rejection of Claims 1-8 and 18-23**

Claims 1-8 and 18-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laverty, et al.* (U.S. Pat. No. 6,791,707). Applicant respectfully traverses.

Independent claim 1 provides as follows:

1. A method of performing automated shipping in a commercial printing environment including a designer location and a print service provider location, said method comprising:

creating at the designer location a digital file that represents an image to be printed;

receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location;

generating at the designer location shipping instructions that describe how a printed output is to be shipped after printing and packaging, the shipping instructions being generated relative to the received configuration information;

creating at the designer location a high performance file that contains the digital file and the shipping instructions;

submitting the high performance file from the designer location to the print service provider location via an electronic network; and

generating at the print service provider location a printed output of the digital file and shipping the printed output at the print service provider location in accordance with shipping instructions contained within the high performance file.

As a preliminary matter, Applicant objects to the manner in which the Examiner has rejected Applicant's claim 1. In particular, the Examiner has simply block copied

claim 1 and provided a citation to column 10, lines 15-67 and column 11 lines 1-13 without providing guidance as to which specific portions of those sections the Examiner believes account for Applicant's various individual claim limitations. The Examiner's omnibus approach to rejecting claim 1 denies Applicant a "full and fair hearing" given that Applicant cannot determine the precise basis for the Examiner's rejections. See MPEP 706.07. Applicant therefore submits that the rejections are improper and should be withdrawn.

Turning to the merits of claim 1, Applicant notes that Lavery fails to disclose or suggest nearly every limitation of that claim. First, Lavery does not disclose or suggest "creating at the designer location a digital file that represents an image to be printed". Instead, Lavery discloses that a customer (which the Examiner has treated as the claimed "designer") "inputs data" to be printed using on a web site of the printer. *Lavery*, column 10, lines 26-29. More particularly, Lavery inputs that data in a "pre-configured order form." *Lavery*, column 10, lines 40-43. Clearly, entering data into a web based order form is not creating a file "at the designer location". Instead, such a situation is providing data to another so that they may create such a file.

Second, Lavery does not disclose or suggest "receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location". Regarding that limitation, Lavery says nothing in the sections cited by the Examiner about the customer/designer receiving *any* information regarding a print production device, whether that information be real time or static. If the Examiner disagrees, Applicant requests that the Examiner specifically identify the particular portion of Lavery's disclosure where Lavery mentions

providing real time configuration information regarding a print production device to a customer/designer.

Third, Lavery does not disclose or suggest “generating at the designer location shipping instructions that describe how a printed output is to be shipped after printing and packaging, the shipping instructions being generated relative to the received configuration information”. Simply stated, Lavery says nothing about a customer/designer generating shipping instructions, whether they are generated relative to configuration information or not.

Fourth, Lavery does not disclose or suggest “creating at the designer location a high performance file that contains the digital file and the shipping instructions”. Instead, Lavery expressly states that the “system” generates a Print Ready File using the data provided by the customer/designer. As expressed by Lavery:

The customer goes to the web site and selects a particular product to order. The web site loads a pre-configured order form for the selected product, and the customer enters the data they wish to appear on the business card. *The web site then transmits the data to the system which generates the Print Ready File (e.g., as a unique PostScript file).*

*Lavery*, column 10, lines 39-45 (emphasis added). Given that the customer/designer is not the identified “system,” it follows that the customer/designer does not create a high performance file “at the designer location” as required by claim 1.

Fifth, Lavery does not disclose or suggest “submitting the high performance file from the designer location to the print service provider location via an electronic network”. Given that the customer/designer does not create the high performance file it

logically follows that the high performance file is not “submitted” from the “designer location” to a print service provider location.

In view of the above, it is clear that Lavery does not in fact render Applicant’s claim 1 obvious. Applicant therefore respectfully submits that claim 1 and its dependents are allowable. Applicant further respectfully submits that claim 18 and its dependents are allowable for similar reasons given that claim 18 comprises limitations similar to those described above in relation to claim 1.

**B. Rejection of Claims 5, 6, and 8-23**

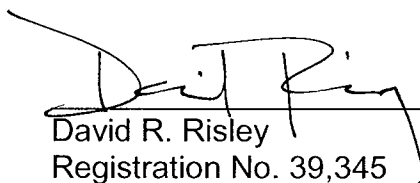
Claims 5, 6, and 8-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lavery* in view of *FedEx*. Applicant respectfully traverses the rejection.

As identified above, Lavery does not teach aspects of Applicant’s claims. In that FedEx does not remedy the deficiencies of the Lavery reference, Applicant respectfully submits that claims 5, 6, and 8-23 are allowable over the Lavery/FedEx combination for at least the same reasons that claims 1 and 18 are allowable over Lavery.

### **CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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